



GREENBLUM & BERNSTEIN, P.L.C.  
Intellectual Property Causes  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

AFZ  
JPW

In re application of: S. SCHRAGA

Attorney Docket No. P23568

Application No. : 10/641,142

**Mail Stop Appeal Brief-Patents**  
Group Art Unit : 3731

Filed : August 15, 2003

Examiner : M. H. Thaler

For : ADJUSTABLE LANCET DEVICE AND METHOD

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Appeal Brief-Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Appeal Brief Under 37 C.F.R. § 41.37** in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ An Information Disclosure Statement, PTO Form 1449, and references cited.
- ☐ A Request for Extension of Time.
- ☐ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 44	44	0	x25=	\$	x 50=	\$0.00
Indep. Claims: 3	3	0	x100=	\$	x200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for <u>  </u> Month(s)				\$		\$0.00
Requisite fee under 37 CFR 41.20(b)(2)						\$250.00
* If less than 20, write 20			Total:	\$	Total:	\$250.00
** If less than 3, write 3						

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$           .

☒ A check in the amount of \$250.00 to cover the filing fee is included.

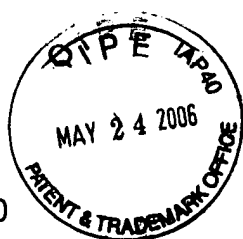
☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Neil F. Greenblum  
Reg. No. 28,394

Stephen M. Roylance  
Reg. No. 31,296



P23568.A10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : S. SCHRAGA

Confirmation No. 8544

Serial No : 10/641,142

Group Art Unit: 3731

Filed : August 15, 2003

Examiner: M. H. Thaler

For : ADJUSTABLE LANCET DEVICE AND METHOD

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Window, Mail Stop Appeal Brief-Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
Sir:

This appeal is from the Examiner's final rejection of claims 1-3 and 8-44 as set forth in the Final Office Action of November 28, 2006. A Notice of Appeal and a Request For Pre-Appeal Brief Review, in response to the November 28, 2005 Final Office Action, was filed on February 28, 2006. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on April 24, 2006 informing Applicant to proceed to the Board of Appeals and Interferences.

A check in the amount of \$ 250.00 is being concurrently submitted as payment of the requisite fee under 37 C.F.R. 41.20(b)(2). No additional fee is believed to be required for filing the instant Appeal Brief. However, if for any reason a necessary fee is required for consideration of the instant paper, authorization is hereby given to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 19-0089.

05/25/2006 SZEWDIE1 00000025 10641142

01 FC:2402

250.00 0P

**TABLE OF CONTENTS**

<b>I</b>	<b>REAL PARTY IN INTEREST .....</b>	<b>Page 3</b>
<b>II</b>	<b>RELATED APPEALS AND INTERFERENCES .....</b>	<b>Page 3</b>
<b>III</b>	<b>STATUS OF CLAIMS .....</b>	<b>Page 3</b>
<b>IV</b>	<b>STATUS OF THE AMENDMENTS.....</b>	<b>Page 3</b>
<b>V</b>	<b>SUMMARY OF THE CLAIMED SUBJECT MATTER.....</b>	<b>Pages 3-5</b>
<b>VI</b>	<b>GROUND OF REJECTION TO BE REVIEWED ON APPEAL ..</b>	<b>Pages 5-6</b>
<b>VII</b>	<b>ARGUMENTS RE. § 112 REJECTION .....</b>	<b>Pages 6-7</b>
<b>VIII</b>	<b>ARGUMENTS RE. § 102/103 REJECTION .....</b>	<b>Pages 7-13</b>
<b>IX</b>	<b>ARGUMENTS RE. § 103 REJECTION .....</b>	<b>Pages 13-20</b>
<b>X</b>	<b>CONCLUSION .....</b>	<b>Page 20</b>
	<b>CLAIMS APPENDIX .....</b>	<b>Pages 21-27</b>
	<b>EVIDENCE APPENDIX .....</b>	<b>Page 28</b>
	<b>RELATED PROCEEDINGS APPENDIX .....</b>	<b>Page 29</b>

P23568.A10

**(I) REAL PARTY IN INTEREST**

The real party in interest is Stat Medical Devices, Inc. by an assignment recorded in the U.S. Patent and Trademark Office on August 15, 2003, at Reel 014396 and Frame 0767.

**(II) RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

**(III) STATUS OF THE CLAIMS**

Claims 1-3 and 8-44 stand finally rejected. Claims 1-44 are pending. Claims 4-7 stand withdrawn. Claims 1-3 and 8-44 are the subject of this appeal. The claims in issue are attached in the "Claims Appendix".

**(IV) STATUS OF THE AMENDMENTS**

A Response under 37 C.F.R. § 1.116 was filed January 30, 2006, requesting reconsideration of the finally rejected claims. The Examiner responded with an Advisory Action mailed on February 14, 2006, indicating that the Response was considered, but did not place the application in condition for allowance. Appellant submits that no other amendments after final have been filed; however, all amendments to the claims have been entered.

**(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**

A. The Claimed Subject Matter

**1. INDEPENDENT CLAIM 1**

With reference to paragraphs [0023] – [0074] of the instant application and to e.g.

P23568.A10

Figs.29-40, and by way of non-limiting example, the invention provides for a lancet device LD, comprising a body 501m/501n/402, a trigger 409, and a front cover 403 comprising a skin engaging end P that includes a lancet opening LO through which a lancet needle may extend. A holding member 505 is movably mounted within the body and comprises a front end 404 and a rear end 405b. A main spring 406 is disposed between the front and rear ends of the holding member 505 (see Fig. 36). The front end 404 is configured to receive a lancet 10. A first stop surface MSS moves with the holding member 505. A second stop surface FSS is non-movably coupled to the body. The second stop surface FSS extends inwardly (on portion 402b) from the body and is arranged between the first stop surface MSS and the skin engaging end P. At least partial rotation of the front cover 403 causes the skin engaging end P to move axially relative to the second stop surface FSS. See also paragraphs [0053] – [0065] of the instant application.

## **2. INDEPENDENT CLAIM 43**

With reference to paragraphs [0023] – [0074] of the instant application and to e.g. Figs. 29-40, and by way of non-limiting example, the invention provides for a lancet device LD, comprising a body 501m/501n/402, a front cover 403 comprising a skin engaging end P that includes a lancet opening LO through which a lancet needle may extend, and a holding member 505 movably mounted within the body. The holding member 505 comprises a front end 404 and a rear end 405b. The front end 404 is configured to receive a lancet 10. A main spring 406 is disposed between the front and rear ends of the holding member 505. A first stop surface MSS is arranged on a front

P23568.A10

portion 404 of the holding member 505. A second stop surface FSS is axially retained to a front portion 402 of the body. At least partial rotation of the front cover 403 causes the skin engaging end P to move axially relative to the second stop surface FSS. See also paragraphs [0053] – [0065] of the instant application.

### **3. INDEPENDENT CLAIM 44**

With reference to paragraphs [0023] – [0074] of the instant application and to e.g. Figs. 29-40, and by way of non-limiting example, the invention provides for a lancet device LD, comprising a body 501m/501n/402, a trigger 409, and a front cover 403 comprising a skin engaging end P that includes a lancet opening LO through which a lancet needle may extend. A holding member 505 is movably mounted within the body. The holding member 505 comprising a front end 404 and a rear end 405b. The front end 404 is configured to receive a lancet 10. A first spring 406 is disposed between the front end 404 of the holding member 505 and a surface FSS of the body. A back cap 412 is configured to move the holding member 505 to a retracted position (see Fig. 32). A second spring 415 disposed between the rear end 405b of the holding member 505 and a surface 412c of the back cap 412. A first stop surface MSS is coupled to a front portion 404 of the holding member 505. A second stop surface FSS is axially retained to a front portion 402 of the body. At least partial rotation of the front cover 403 causes the skin engaging end P to move axially relative to the second stop surface FSS. See also paragraphs [0053] – [0065] of the instant application.

### **(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**Whether claims 1-3 and 8-42 are improperly rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph as being indefinite.**

P23568.A10

**Whether claims 1-3, 8-23, 27-31 and 36-42 are improperly rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,156,051 issued to SCHRAGA, or in the alternative as being unpatentable over SCHRAGA alone.**

**Whether claims 24-26 and 32-35 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over SCHRAGA alone.**

**Whether claims 43 and 44 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,469,110 to SLAMA in view of SCHRAGA.**

**(VII) ARGUMENT RE. 112, 2<sup>nd</sup> PARAGRAPH, REJECTION**

**REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH IS IN ERROR**

The rejection of claim 1 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserts that claim 1 is indefinite because it recites that the second stop surface FSS extends inwardly from the body when in fact the second stop surface is part of the body.

Appellant respectfully submits that claim 1 is not indefinite. There is no contradiction between the second stop surface FSS extending inwardly from the body (which is in fact shown in the drawings, see e.g., Fig. 32) and this annular stop surface being integrally formed with portion 402 of the body. In fact, in each of the disclosed embodiments, the second stop surface FSS clearly extends inwardly from the body or from a portion of the body, and the Examiner has not demonstrated otherwise.

P23568.A10

Appellant respectfully submits that Appellant is not required to limit the invention to only the preferred embodiments disclosed in the specification. Finally, Appellant submits that one having ordinary skill in the art, having read the specification and figures, would have no difficulty understanding the invention as claimed. The Examiner has not demonstrated otherwise.

Because each of the features recited in claim 1 would be readily understood by one having ordinary skill in the art, Appellant submits that each of the features in claim 1 are clear and are not indefinite, and this rejection should be reversed.

#### **(VIII) ARGUMENT RE. 102(b)/103(a) REJECTION**

##### **REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner asserts that SCHRAGA discloses or suggests, among other things, a second stop surface that is non-movably coupled to the body and that at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface. Applicant respectfully disagrees.

While the Examiner has identified the second stop surface in SCHRAGA as the lower surface of member 174 in Fig. 16, the Examiner has apparently failed to appreciate that member 174 is part of member 20C which is threadably and movably



P23568.A10

connected to the body 20A via threads 170/172 (see col. 14, lines 17-35). Thus, the Examiner is not correct that member 174 is non-movably coupled to the body.

Furthermore, while the Examiner has asserted that partial rotation of cover 50 causes the skin engaging end to move axially relative to the second stop surface, and identified col. 14, lines 21-24 of SCHRAGA as disclosing this feature, the Examiner has failed to appreciate that because the cover 50 has a triangular cross-section and slides onto a triangular portion of the body 20, it cannot possibly rotate relative to the body 20. Furthermore, as col. 14, lines 21-24 of SCHRAGA merely discusses the adjustability of the upper housing 20A relative to the middle housing 20C, the Examiner cannot reasonably argue that either of these parts is a front cover. Appellant respectfully submits that the front cover recited in claim 1 is defined as having a skin engaging end that includes a lancet opening through which a lancet needle may extend. Neither of the body portions 20A and 20C include this feature.

Thus, Appellant submits that SCHRAGA fails to disclose or suggest the features recited in at least independent claim 1. Because no proper modification of SCHRAGA discloses or suggests at least the above-noted features of the instant invention, Appellant submits that no proper modification of this document can render unpatentable the combination of features recited in at least independent claim 1.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify SCHRAGA in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for the missing features or for the motivation to modify this document, in the manner suggested by the Examiner.

P23568.A10

Therefore, Appellant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of this document, and this rejection should be reversed.

**REJECTION OF DEPENDENT CLAIM 17 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 17 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 17 depends from claim 1 and further recites a mechanism for at least temporarily maintaining a depth setting position of the front cover.

SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. The invention, in contrast, utilizes rotation of the front cover to adjust penetration depth of the lancet needle. Appellant emphasizes that SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Finally, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 17.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 17, and this rejection should be reversed.

**REJECTION OF INDEPENDENT CLAIM 30 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 30 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 30 depends from claim 1, and further recites that the front cover rotates about an axis that runs through the lancet opening and the holding member.

As explained above, SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. Again, the invention utilizes rotation of the front cover to adjust penetration depth of the lancet needle. SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Furthermore, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 30.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 30, and this rejection should be reversed.

**REJECTION OF DEPENDENT CLAIM 39 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 39 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is

P23568.A10

in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 39 depends from claim 1, and further recites that the front cover comprises gripping protrusions.

As explained above, SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. As such, the front cover 50 lacks any gripping protrusions. Nor would it make sense to place any gripping protrusions on the front cover as it does not participate in penetration depth adjustment. Again, the invention utilizes rotation of the front cover to adjust penetration depth of the lancet needle. SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Furthermore, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 26.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 39, and this rejection should be reversed.

**REJECTION OF DEPENDENT CLAIM 40 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 40 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is

P23568.A10

in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 40 depends from claim 1, and further recites threads connecting the front cover to the body.

Again, SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. As such, the front cover 50 lacks threads. Nor would it make sense to place any threads on the front cover as it does not participate in penetration depth adjustment. Again, the invention utilizes rotation of the front cover to adjust penetration depth of the lancet needle. SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Furthermore, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 40.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 40, and this rejection should be reversed.

**REJECTION OF DEPENDENT CLAIM 42 UNDER 35 U.S.C. § 102/103 IS IN ERROR**

The rejection of claim 42 under 35 U.S.C. § 102(b) as anticipated or as unpatentable under 35 U.S.C. § 103(a) over US patent 6,156,051 to SCHRAGA alone is in error, the decision of the Examiner to reject this claim should be reversed, and the

P23568.A10

application should be remanded to the Examiner.

Claim 42 depends from claim 1, and recites, among other things, rotating the front cover to a desired set position.

Again, SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. Again, the invention utilizes rotation of the front cover to adjust penetration depth of the lancet needle. SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Furthermore, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 40.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 42, and this rejection should be reversed.

#### **(IX) ARGUMENT RE. 103(a) REJECTION**

##### **REJECTION OF DEPENDENT CLAIM 26 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over US patent 6,156,051 to SCHRAGA alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 26 depends from claim 1, and further recites the indicia arranged on an outer circumferential surface of the front cover.

As explained above, SCHRAGA discloses a triangular front cover 50 that slides onto the body 20 and that does not rotate relative to the body 20. Nor is there any penetration depth adjustment between the front cover 50 and body 20. As such, the front cover 50 lacks an outer circumferential surface. Nor would it make sense to place indicia on the front cover as it does not participate in penetration depth adjustment. Again, the invention utilizes rotation of the front cover to adjust penetration depth of the lancet needle. SCHRAGA only provides penetration depth adjustment in the rear portion of the body (see Figs. 14-18) or on the front end of the holding member 30 (see e.g., Fig. 1). Furthermore, Appellant submits that the Examiner has failed to identify any language in SCHRAGA which discloses or suggests the features recited in claim 26.

Because SCHRAGA fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading or modification of SCHRAGA renders unpatentable the combination of features recited in at least dependent claim 26, and this rejection should be reversed.

**REJECTION OF INDEPENDENT CLAIM 43 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over US patent 4,469,110 to SLAMA in view of U.S. Patent No. 6,156,051 to SCHRAGA is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner acknowledged that SLAMA lacks, among other things, the features

P23568.A10

recited in the above-noted claims such as the recited main spring disposed between the front and rear ends of the holding member. However, the Examiner asserted that this feature is taught in SCHRAGA and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what each of SLAMA and SCHRAGA discloses or suggests, Appellant submits that no proper combination of these documents discloses or suggests: inter alia, a main spring disposed between the front and rear ends of the holding member and a second stop surface axially retained to a front portion of the body, as recited in independent claim 43.

Appellant acknowledges that SLAMA discloses a lancet device which utilizes, among other things, a body 2, a front cover 10, and a holding member 3. Nor does Appellant dispute that the front end of the holding member 3 has a first stop surface which moves and engages with a second stop surface arranged on a rear end of the front cover 10. Indeed, Fig. 4 of SLAMA clearly shows such contact. However, it is clear that the second stop surface (i.e., the one arranged on the rear end of the front cover 10) is not axially retained to a front portion of the body 2. To the contrary, this surface is arranged on a rear end of the front cover 10 and not the body 2. Nor is this surface properly characterized as axially retained. As is evident from Fig. 3, rotation of the front cover 10 causes this surface to move axially. A surface which can move axially and which is arranged on a front cover 10 simply cannot be characterized as a surface that is axially retained to a front portion of the body.



It is also clear that SLAMA fails to disclose, or even suggest, a main spring disposed between the front and rear ends of the holding member. Indeed, the Examiner has acknowledged as much in the instant Office Action.

With regard to SCHRAGA, Appellant acknowledges that SCHRAGA discloses a lancet device (see e.g., Fig. 16) which utilizes, among other things, a body, a front cover, a holding member, two springs, and a back cap. However, it is clear that the second stop surface 28, while being non-movably coupled to the body and extending inwardly therefrom (see Fig. 2), is not arranged between the recited first stop surface and the skin engaging end.

It is also clear that SCHRAGA fails to disclose, or even suggest, the combination of a first stop surface coupled to or arranged on a front portion of the holding member and a second stop surface axially retained to a front portion of the body. To the contrary, Fig. 2 shows the second stop surface 28 is arranged at a rear portion of the body and not on a front portion of the body. Moreover, the first stop surface, while clearly coupled to the holding member 32, is not coupled to or arranged on a front portion of the holding member 32. To the contrary, Fig. 2 shows a first stop surface coupled to member 33 which is arranged on the rear portion of the holding member 32.

Thus, Appellant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claim 43. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Appellant submits that no proper modification of these documents can render unpatentable the combination of features recited in at

least independent claim 43.

Furthermore, Appellant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claim 43 is not rendered obvious by any reasonable inspection of these documents. Accordingly, this rejection should be reversed.

**REJECTION OF INDEPENDENT CLAIM 44 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 44 under 35 U.S.C. § 103(a) as being unpatentable over US patent 4,469,110 to SLAMA in view of U.S. Patent No. 6,156,051 to SCHRAGA is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

The Examiner acknowledged that SLAMA lacks, among other things, the features recited in the above-noted claims such as the recited first spring disposed between the front and rear ends of the holding member. However, the Examiner asserted that this feature is taught in SCHRAGA and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Appellant respectfully traverses this rejection.

Notwithstanding the Examiner's assertions as to what each of SLAMA and SCHRAGA discloses or suggests, Appellant submits that no proper combination of these documents discloses or suggests: inter alia, a back cap configured to move the

P23568.A10

holding member to a retracted position, a second spring disposed between the rear end of the holding member and a surface of the back cap, and a second stop surface axially retained to a front portion of the body, as recited in independent claim 44.

Again, Appellant acknowledges that SLAMA discloses a lancet device which utilizes, among other things, a body 2, a front cover 10, and a holding member 3. Appellant also does not dispute that the front end of the holding member 3 has a first stop surface which moves and engages with a second stop surface arranged on a rear end of the front cover 10. Indeed, Fig. 4 of SLAMA clearly shows such contact. However, it is clear that the second stop surface (i.e., the one arranged on the rear end of the front cover 10) is not axially retained to a front portion of the body 2. To the contrary, this surface is arranged on a rear end of the front cover 10 and not the body 2. Nor is this surface properly characterized as axially retained. As the Examiner will note from Fig. 3, rotation of the front cover 10 causes this surface to move axially. A surface which can move axially and which is arranged on a front cover 10 simply cannot be characterized as a surface that is axially retained to a front portion of the body.

It is also clear that SLAMA fails to disclose, or even suggest, a first spring disposed between the front and rear ends of the holding member. Indeed, the Examiner has acknowledged as much in the instant Office Action.

Appellant also submits that SLAMA fails to disclose, or even suggest, a back cap configured to move the holding member to a retracted position and/or a second spring disposed between the rear end of the holding member and a surface of the back cap. Indeed, the Examiner has failed to identify any of these features in SLAMA. Nor can

the Examiner do so from a fair review of the figures of SLAMA. As is evident from Figs. 1-5, the body 2 has a closed rear end and merely utilizes a single spring 4.

With regard to SCHRAGA, Appellant acknowledges that SCHRAGA discloses a lancet device (see e.g., Fig. 16) which utilizes, among other things, a body, a front cover, a holding member, two springs, and a back cap. However, it is clear that the second stop surface 28, while being non-movably coupled to the body and extending inwardly therefrom (see Fig. 2), is not arranged between the recited first stop surface and the skin engaging end.

It is also clear that SCHRAGA fails to disclose, or even suggest, the combination of a first stop surface coupled to or arranged on a front portion of the holding member and a second stop surface axially retained to a front portion of the body. To the contrary, Fig. 2 shows the second stop surface 28 is arranged at a rear portion of the body and not on a front portion of the body. Moreover, the first stop surface, while clearly coupled to the holding member 32, is not coupled to or arranged on a front portion of the holding member 32. To the contrary, Fig. 2 shows a first stop surface coupled to member 33 which is arranged on the rear portion of the holding member 32.

Thus, Appellant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claim 44. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Appellant submits that no proper modification of these documents can render unpatentable the combination of features recited in at least independent claim 44.

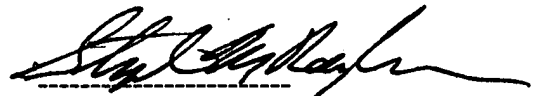
P23568.A10

Furthermore, Appellant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Appellant submits that the invention as recited in at least independent claim 44 is not rendered obvious by any reasonable inspection of these documents. Accordingly, this rejection should be reversed.

**(X) CONCLUSION**

Each of claims 1-3 and 8-44 are patentable under 35 U.S.C. §§ 112, 102(b) and 103(a). Specifically, the applied art of record, even if properly combined, fails to disclose or suggest the unique combination of features recited in Appellant's claims 1-3 and 8-44. Accordingly, Appellant respectfully requests that the Board reverse the decision of the Examiner to reject claims 1-3 and 8-44 under 35 U.S.C. §103(a), and remand the application to the Examiner for withdrawal of the above-noted rejections.

Respectfully submitted,  
S. SCHRAGA



Neil F. Greenblum  
Reg. No. 28,394

Stephen M. Roylance  
Reg. No. 31,296

May 23, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
703-716-1191

Attachments: Claims Appendix, Evidence Appendix, and Related Proceedings Appendix

CLAIMS ON APPEAL

1. A lancet device, comprising:
  - a body;
  - a trigger;
  - a front cover comprising a skin engaging end that includes a lancet opening through which a lancet needle may extend;
  - a holding member movably mounted within the body and comprising a front end and a rear end;
  - a main spring disposed between the front and rear ends of the holding member;
  - the front end being configured to receive a lancet;
  - a first stop surface that moves with the holding member;
  - a second stop surface non-movably coupled to the body; and
  - the second stop surface extending inwardly from the body and being arranged between the first stop surface and the skin engaging end,
  - wherein at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface.
2. The lancet device of claim 1, further comprising a back cap configured to move between a retracted position and an original position.
3. The lancet device of claim 2, wherein the back cap is configured to move the holding member to a retracted position.
4. The lancet device of claim 2, wherein the back cap is coupled to a surface that engages the rear end of the holding member.
5. The lancet device of claim 2, wherein the back cap includes a surface that engages the rear end of the holding member.

P23568.A10

6. The lancet device of claim 5, wherein the back cap comprises an opening that receives a rear end of the holding member.

7. The lancet device of claim 2, wherein the back cap includes a surface that engages projections disposed on the rear end of the holding member.

8. The lancet device of claim 2, further comprising another spring for biasing the back cap towards an original position.

9. The lancet device of claim 1, wherein the main spring biases the holding member towards an extended position, and further comprising another spring for biasing the holding member in an opposite direction.

10. The lancet device of claim 9, wherein said main spring and said other spring are arranged to surround portions of the holding member.

11. The lancet device of claim 9, wherein the main spring is coupled one side of the holding member and to a surface of the body.

12. The lancet device of claim 11, wherein the holding member comprises cylindrical surfaces and a polygonal cross-sectional shape.

13. The lancet device of claim 11, further comprising a locking member mounted to the rear end of the holding member.

14. The lancet device of claim 13, wherein the main spring surrounds a portion of the holding member and wherein the other spring is disposed between a surface of a back cap and the locking member.

P23568.A10

15. The lancet device of claim 1, wherein the trigger is movably mounted to the body.

16. The lancet device of claim 1, wherein the front cover is removably mounted to the body.

17. The lancet device of claim 1, further comprising a mechanism for at least temporarily maintaining a depth setting position of the front cover.

18. The lancet device of claim 1, wherein the holding member comprises an integrally formed deflecting member that engages a surface of the body.

19. The lancet device of claim 1, wherein the front end comprises an opening that is configured to removably receive the lancet.

20. The lancet device of claim 1, further comprising a deflecting member configured to be deflected by the trigger.

21. The lancet device of claim 20, wherein the deflecting member is coupled to the holding member.

22. The lancet device of claim 20, wherein the deflecting member comprises an engaging surface that contacts a surface of the body.

23. The lancet device of claim 22, wherein the deflecting member is integrally formed with the holding member.

24. The lancet device of claim 1, further comprising indicia arranged on at least one of the front cover and the body.



P23568.A10

25. The lancet device of claim 24, wherein the indicia is arranged on an outer circumferential surface of the body.

26. The lancet device of claim 24, wherein the indicia is arranged on an outer circumferential surface of the front cover.

27. The lancet device of claim 1, wherein the holding member comprises a front portion that includes the front end and a rear portion that includes the rear end, wherein the front and rear portions are connected together.

28. The lancet device of claim 27, wherein the rear portion comprises a locking end which receives a locking member.

29. The lancet device of claim 28, wherein the front portion comprises a deflecting member configured to be deflected by the trigger.

30. The lancet device of claim 1, wherein the front cover rotates about an axis that runs through the lancet opening and the holding member.

31. The lancet device of claim 1, wherein the main spring is disposed between the trigger and a back cap.

32. The lancet device of claim 1, wherein the body comprises a two-piece body.

33. The lancet device of claim 32, further comprising another spring axially retained between walls of the two-piece body.

P23568.A10

34. The lancet device of claim 33, wherein the front cover is removably mounted to the two-piece body.

35. The lancet device of claim 34, further comprising a back cap movably mounted to the two-piece body.

36. The lancet device of claim 1, wherein the body comprises an ergonomic shape.

37. The lancet device of claim 1, wherein the body comprises cylindrical surfaces.

38. The lancet device of claim 1, wherein the body comprises a plastic material.

39. The lancet device of claim 1, wherein the front cover comprises gripping protrusions.

40. The lancet device of claim 1, further comprising threads connecting the front cover to the body.

41. A method of puncturing a surface of skin using the lancet device of claim 1, the method comprising:

adjusting a set depth of penetration of the needle by rotating the front cover to a desired set position;

disposing the skin engaging end of the lancet device against a user's skin;  
and

triggering the trigger to cause the lancet needle to penetrate the user's skin,  
wherein the puncture allows a blood sample to be taken.

P23568.A10

42. A method of using the lancet device of claim 1, the method comprising:  
rotating the front cover to a desired set position;  
moving the holding member to a retracted position;  
maintaining the holding member in the retracted position until the trigger is triggered;  
disposing the skin engaging end of the lancet device against a user's skin;  
and  
triggering the trigger to cause movement of the holding member.

43. A lancet device, comprising:  
a body;  
a front cover comprising a skin engaging end that includes a lancet opening through which a lancet needle may extend;  
a holding member movably mounted within the body, the holding member comprising a front end and a rear end;  
the front end being configured to receive a lancet;  
a main spring disposed between the front and rear ends of the holding member;  
a first stop surface arranged on a front portion of the holding member; and  
a second stop surface axially retained to a front portion of the body,  
wherein at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface.

44. A lancet device, comprising:  
a body;  
a trigger;  
a front cover comprising a skin engaging end that includes a lancet opening through which a lancet needle may extend;

P23568.A10

a holding member movably mounted within the body, the holding member comprising a front end and a rear end;

the front end being configured to receive a lancet;

a first spring disposed between the front end of the holding member and a surface of the body;

a back cap configured to move the holding member to a retracted position;

a second spring disposed between the rear end of the holding member and a surface of the back cap;

a first stop surface coupled to a front portion of the holding member; and

a second stop surface axially retained to a front portion of the body,

wherein at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface.

P23568.A10

EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 35 U.S.C. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 35 U.S.C. §41.37(c)(ix).

NO.	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
1	N/A	N/A

P23568.A10

RELATED PROCEEDINGS APPENDIX

Pursuant to 35 U.S.C. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 35 U.S.C. §41.37(c)(1)(ii) are enclosed herewith.

NO.	TYPE OF PROCEEDING	REFERENCE NO.	DATE
1	N/A	N/A	N/A